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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,153	05/08/2001	Daryl J. Orris	1003.001US2	9662

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EXAMINER	
SHERRER, CURTIS EDWARD	
ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	09/850,153	ORRIS ET AL.	
	Examiner	Art Unit	
	Curtis E. Sherrer, Esq.	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08/05/03*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) *1-5,16-21 and 29-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *6-15, 22-28, 33 and 34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

> The oath or declaration is defective because:
> It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 15, and 28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All of the above claims are considered indefinite because is unclear how the members of the Markush group listed said claims can be gums. While applicants can be their own lexicographers, it is improper to distort the commonly held definitions of terms.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakaya *et al.* (U.S. Pat. No. 4,988,529)("Nakaya").

Nakaya teaches the production of milk shakes that is produced from an ice cream that comprises 15-35% sugar, 0.3-1.3 weight % of alcohol and 1-7 weight % protein and 1-25 weight % fat (col. 2, lines 45 to 50). The protein can be comprised of whey protein, milk protein etc. (Col. 6, lines 6 to 12). The ice cream can also contain emulsifiers, stabilizers, flavors, seasonings, coloring agents, etc. (Col. 5, lines 5 to 10). The upper limit of alcohol is set so that "the alcohol smell [will not] become too strong." (Col. 6, lines 4 to 5). "Examples of stabilizers include waterbinding gum, gelling agents and blocking agents" such as locust bean gum, carrageenan, microcrystalline cellulose, carboxy methyl cellulose, etc. (Col. 5, lines 29 to 38).

Nakaya does not teach adding the alcohol after the preparation of the stabilized ice cream mix. The patent does state that countless tiny ice pieces of iced mixed if an das necessary in ice cream may be of water admixed for instance, with some fruit juice, fruit particles or pieces, sugar, stabilizer, pigment, flavor, acidic seasoning and other tasty substances. (col. 6, lines 35-41). Therefore, Nakaya suggest to those of ordinary skill in the art to add ingredients together with ice to a chilled ice cream product. It would have been obvious to those of ordinary skill in

the art to add ethyl alcohol to the stabilized ice cream blend of Nakaya because said patent teaches adding flavors, etc. to said blend.

Further, it would have been obvious to add the alcohol last as it is well known to modify the order of adding ingredients. Courts have long held that the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930).

Applicants submitted the Smith Declaration to show unexpected results. First, the results are not couched in terms of "unexpected results." Second, it is not clear, if what was tested, was commensurate in scope with what was claimed, i.e., specific composition and amounts of base mix. It is not stated to what specific temperature the alcohol was lowered. Do any and all temperatures provide the same results? Further, no specific amounts of alcohol are claimed and therefore tests should be performed at any and all amounts, e.g., very low to very high. It is not stated as to whether the base mix was chilled before adding the alcohol. In conclusion, the Declaration is short on detail and therefore is not determinative of unexpected results. Finally, Applicants' attention is invited to *In re Levin*, 84 U.S.P.Q. 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

> This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents)

956, 39 F.2d 974, 5 U.S.P.Q. 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 U.S.P.Q. 221.

Claims 22-28, 33 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakaya in view of Applicants' admission and in further view of Arbuckle (Ice Cream, pp. 23-27, 35, 36, 46, 71-83, 96-103, 139-47, 208-23).

Nakaya et al. teach that cited above including a process for producing the ice cream. Nakaya does not teach all the claimed process steps or the specific amounts of ingredients.

On page 11, of the instant specification, Applicants disclose a basic ice cream mix, which is a basic commercial manufacturing formulation.

The Arbuckle reference teaches the various factors involved in the production of ice cream and ice cream products, such as formulation and processing. On page 135, in Table 4.1, the approximate composition of commercial ice cream is shown. On page 36, several basic ingredients of ice cream are listed. On page 69, Table 5.5, the approximated compositions and weights per gallon are given. On page 83, it is stated that "[l]iqueur flavorings include alcohol, whiskey and distilled beverages, fruit brandy distillate, brandy flavor essence and fruit liqueurs." On pages 96 to 103, a list and description of several commonly used stabilizers for ice cream are discussed, such as cellulose gums, carrageenan and locust bean gum. Pages 210-223 describe the order of adding the ingredients, the pasteurization of the mix, the homogenization of the mix, its cooling and aging.

It would have been obvious to one of ordinary skill in the art to produce the ice cream of Nakaya as taught by Arbuckle since the claimed process steps and ingredients are all well known

in the art and it is considered that Applicant is using well known methods and ingredients and obtaining no more than that which is expected. Again, see *In re Levin*.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis E. Sherrer, Esq. whose telephone number is 703-308-3847. The examiner can normally be reached on Tuesday-Friday, 8AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Curtis E. Sherrer, Esq.
Primary Examiner
Art Unit 1761